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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,249	02/05/2001	Robert Amson	06591/0208	2875

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EXAMINER

SHUKLA, RAM R

ART UNIT PAPER NUMBER

1632

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/762,249

Applicant(s)

AMSON ET AL.

Examiner

Ram Shukla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *detailed action*.

**DETAILED ACTION**

1. Claims 1-25 are pending.

***Election/Restrictions***

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Groups 1-15, claim(s) 1-13, 23 and 25, drawn to a nucleotide sequence disclosed in SEQ ID NO: 1-15, a vector comprising each sequence and a host cell transformed with each vector.

Groups 16-32, claim(s) 14, 15, 21 and 22, drawn to a protein encoded by each of the sequences disclosed in SEQ ID NO: 1-15 and a medicine comprising each of the proteins.

Groups 32-48, claim(s) 16, drawn to a pharmaceutical compound that ensures the cellular expression of each of the sequence disclosed in SEQ ID NO: 1-15.

Groups 49-64, claim(s) 17, drawn to a pharmaceutical composition comprising a nucleotide vector that ensures the expression of the protein encoded by each of the sequences disclosed in SEQ ID NO: 1-15.

Groups 65-80, claim(s) 18 and 19, drawn to a pharmaceutical composition that ensures the inhibition of the cellular expression of each of the nucleotide sequences disclosed in SEQ ID NO 1-15.

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Groups 81-96, claim(s) 20 and 24, drawn to a monoclonal antibody directed against the proteins encoded by each of the nucleotide sequences disclosed in SEQ ID NO: 1-15.

3. The inventions listed as Groups 1-15 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The nucleotide sequences disclosed in SEQ ID Nos 1-15 have sequence structure distinct from each other, they encode a protein that has distinct amino acid sequence and the encoded proteins would have distinct functions. Therefore the nucleotide sequences of each of the groups 1-15 would be patentably distinct and lack same special technical feature.

4. The inventions listed as Groups 16-32 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The proteins encoded by the nucleotide sequences disclosed in SEQ ID Nos 1-15 would have amino acid sequence structure distinct from each other, and the encoded proteins would have distinct functions. Accordingly, the inventions of the groups 16-32 lack the same special technical feature.

5. The inventions listed as Groups 33-48 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Since the nucleotide sequences of SEQ ID NO: 1-15 lack the same sequence structure, pharmaceutical composition that ensures the expression of one sequences would not ensure the expression of another nucleotide sequence. For example, a pharmaceutical composition used for treating a condition caused by the expression of the sequence of SEQ ID NO 1 could not used for treating a condition caused by the expression of SEQ ID NO 2-15.

6. The inventions listed as Groups 65-80 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Since the nucleotide sequences of SEQ ID NO: 1-15 lack the same sequence structure, pharmaceutical composition that inhibits the expression of each of the sequences would lack the same technical feature because one pharmaceutical composition could not be used for inhibiting the expression of another sequence.

7. The inventions listed as Groups 81-96 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Since the amino acid sequence encoded by each of the nucleotide sequences of SEQ ID NO: 1-15 are distinct, an antibody produced against one protein would not recognize another protein and therefore the antibodies against each of the proteins would lack the same technical feature.

8. A telephone call was made to Mr. Stephen Maebius on 4-25-02 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

When amending claims, applicants are advised to submit a clean version of each amended claim (without underlining and bracketing) according to § 1.121(c).

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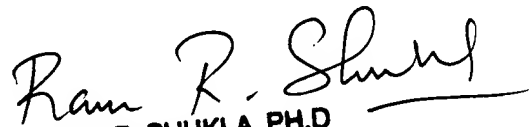
For instructions, Applicants are referred to

<http://www.uspto.gov/web/offices/dcom/olia/aipa/index.htm>.

Applicants are also requested to submit a copy of all the pending/under consideration claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051. The fax phone number for this Group is (703) 308-4242. Any inquiry of a general nature, formal matters or relating to the status of this application or proceeding should be directed to the Dianiece Jacobs whose telephone number is (703) 305-3388.

Ram R. Shukla, Ph.D.

  
RAM R. SHUKLA, PH.D.  
PATENT EXAMINER